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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/757,646

01/11/2001

Makoto Kagaya

2091-0227P-SP

8026

2292

7590

08/27/2004

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EXAMINER

LAMB, TWYLER MARIE

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/757,646

**Applicant(s)**

KAGAYA, MAKOTO

**Examiner**

Twyler M. Lamb

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 01 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Watkins et al. (Watkins) (US 5,778,164).

With regard to claims 1, 7 and 12-15, Watkins discloses a printing system (Figure 1) comprising: a client (CPU 10) having character image information generation means for generating character image information representing desired characters and/or a desired simple image by receiving an input of the

character and/or the simple image (col 7, line 1 – col 9, line 6); and a laboratory server (server 44) having information printing means (output devices 32, 34, 36, 38, 40, 42) for printing the character and/or the simple image at a predetermined position on a print based on the character image information provided from the client, at the time of printing the image (col 6, lines 12-39).

With regard to claims 2 and 8, Watkins also discloses wherein the character image information generation means describes the character image information in order information representing the content of a printing order of the image data, and the information representing the content of a printing order of the image data (col 7, line 1 – col 9, line 6), and the information printing means prints the character and/or the simple image at the predetermined position of the print based on the order information (col 6, lines 12-39).

With regard to claims 3 and 9, Watkins also discloses wherein in the case where the content of the printing order specifies generation of a plurality of prints of the same image, the character image information generation means enables setting the character image information for each of the prints (col 7, line 1 – col 9, line 6), and the information printing means prints the character and/or the simple image represented by the character image information set for each of the prints on the predetermined position of each of the prints (col 6, lines 12-39).

With regard to claims 4 and 10, Watkins also discloses wherein, in the case where the content of the printing order specifies printing of a plurality of sets of the image data, the character image information generating means enables setting one item of the character image information for all prints (col 7, line 1 –

col 9, line 6) and the information printing means prints the character and/or the simple image represented by the character image information at the predetermined position of each of the prints (col 6, lines 12-39).

With regard to claims 5 and 11, Watkins also discloses wherein the client and the laboratory server comprise storage means for storing a table relating a predetermined character and/or a predetermined simple image to code information representing a kind of the character and/or the simple image (col 7, lines 3-10).

With regard to claim 6, Watkins also discloses wherein the client and the laboratory server are connected to each other via a network (data link 13, col 8, lines 6, lines 13-17).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314

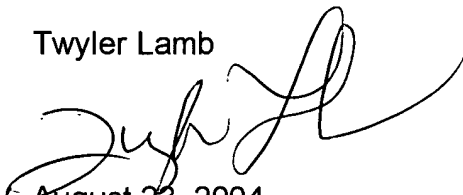
(for informal or draft communications, such as proposed amendments to  
be

discussed at an interview; please label such communications  
"PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

Twyler Lamb



August 23, 2004